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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,515	10/20/2000	Silverbrook Kia	NPA046US	7941
24011	7590	06/08/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/693,515

Applicant(s)

KIA ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 15-17, 19-30, 32-34, 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al (U.S. 6537324), and in view of Kasabach et al (U.S. 6628847).

Regarding claim 1, Tabata discloses a method of enabling graphic design (form design, fig. 2) by means of computer system (computer system, fig. 1), the method including the steps of:

(1) printing (printer 40, fig. 1, col. 5, lines 38-45) on demand, on a surface, a form (form, fig. 2) containing information relating to a graphic design activity (a form containing graphics, texts, and coded data, figs. 2 and 5, col. 8, lines 31-67 to col. 9, lines 1-67 and col. 10, lines 12-30), and at the same time as printing said information, printing on the surface coded data indicative (coded data identifying linkage information of the form, fig. 2, col. 8, lines 32-50 to col. 9, lines 1-67 and col. 10, lines 12-30) of an identity of the form and of at least one reference point (i.e. linkage information specifying a position of each of Dicons on the form, col. 9, lines 13-30 and 10, lines 12-30) of the form.

(2) identifying (identifying coded data via a file server, fig. 3, 18-19), in the computer system and from the indicating data, at least one parameter (i.e. graphic Dicon, fig. 2, col. 9, lines 13-30

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and col. 10, lines 12-30) relating to the graphic design activity. Tabata also discloses a method for receiving (file server, fig. 17), in a computer system, indicating data (coded data, fig. 2) from a sensing device (sensing device 50, fig. 5) regarding the identity of the form (linkage information identifying the form, col. 8, lines 30-50 and col. 10, lines 12-45) and sensing (sensing device 50, fig. 5) the indicating data using at least some of the coded data (coded data identifying linkage information of the form, fig. 2, col. 8, lines 32-50 and col. 10, lines 12-30) but does not explicitly disclose a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form.

Kasabach, in the same field of endeavor for sensing device and graphic design activity, teaches a method for determining a position (position sensor for sensing the location of the sensing device relative to the form/paper, figs. 3-5, col. 3, lines 8-48) of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of Kasabach because of a following reason: (1) to accurately determine the exact location of the sensing device relative to the form to prevent positional errors.

Therefore, it would have been obvious to combine Tabata with Kasabach to obtain the invention as specified in claim 1.

Regarding claim 2, Tabata also teaches the method of claim 1 in which said at least one parameter relating to the graphic design activity is associated with at least one zone (i.e. Title Dicon, fig. 2 of Tabata) of the form in which the method includes identifying, in the computer and from the zone relative to which the sensing device is located, said at least one parameter.

Regarding claims 3-4, Kasabach also teaches the method of claim 2 including the steps of: (1) receiving (computer, col. 8, lines 12-22), in the computer system, data regarding movement (col. 3, lines 1-67) of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data; and (2) identifying (computer, col. 8, lines 12-22), in the computer system and from said movement (col.

3, lines 1-67 and col. 8, lines 12-38) being at least partially within said at least one zone (fig. 3), said at least one parameter of the graphic design activity.

Regarding claims 5-8, Kasabach further teaches the method of claim 1 in which the parameter is an action parameter of the graphic design activity, the method including effecting, in the computer system, an operation in respect of the action parameter (writing and drawing, abstract and col. 3, lines 1-67 and font size, col. 7, lines 60-67).

Regarding claims 9-11, Kasabach further teaches the method of claim 1 in which the parameter is a text parameter of the graphic design activity, the method including identifying, in the computer system, that a user has entered handwritten text data (handwritten text data, abstract and cols. 6-8) by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter.

Regarding claims 15-17, Kasabach further teaches the method of claim 1 in which the parameter is a drawing parameter (col. 6, lines 52-67 and col. 7, lines 15-67) of the graphic design activity, the method including identifying, in the computer system, that a user has entered hand-drawn graphic element (col. 6, lines 52-67 and col. 7, lines 15-67) by means of the sensing device (writing pen, fig. 5) and effecting, in the computer system, an operation associated with the drawing parameter.

Regarding claim 19, Tabata further teaches the method of claim 1 including retaining a retrievable record (cols. 13-14) of each form generated, the form being retrievable using its identity as contained in its coded data.

Regarding claim 20, Tabata further teaches the method of claim 1 in which the sensing device contains an identification which imparts a unique identity (col. 3, lines 15-60) to the sensing device and identifies it as being associated with a particular user and in which the method includes monitoring, in the computer system, said identity.

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Regarding claim 21, Kasabach further teaches the method of claim 1 including providing all required information relating to the graphic design activity (cols. 6-8) in the form to eliminate the need for a separate display device.

Regarding claim 22, Tabata further teaches the method of claim 1 in which the form is printed (printer 40, fig. 1) on multiple pages and in which the method includes binding the pages (method for binding pages are known in the art, i.e. using stapler, tape, clips, and etc).

Regarding claims 23-30, 32-34, 36-37, please see rejection rationale/basis as described in claims 1-6, 8, 11, 16-17, 19-20, and 22 for more details.

4. Claims 12-14, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata and Kasabach as applied to claim 1 and/or 23 above, and further in view of Wolff et al (U.S. 6081261).

Regarding claims 12-14, and 31, the combinations of Tabata and Kasabach teach the method of handwritten recognition (Kasabach, col. 6-7), but does not explicitly teach the method in which the parameter is an authorization parameter of the graphic design activity, the method including identifying, in the computer system, that a user has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter.

Wolff, in the same field of endeavor for handwritten recognition and sensing device, teaches the method in which the parameter is an authorization parameter of the graphic design activity, the method including identifying, in the computer system, that a user has entered a handwritten signature (signature verification, col. 2, lines 58-62 and col. 8, lines 56-67) by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata and Kasabach as per teachings of Wolff because of a following reason: (1) to prevent forgers/unauthorized users accessing confidential materials/documents by using signature verification technique.

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Therefore, it would have been obvious to combine Tabata and Kasabach with Wolff to obtain the invention as specified in claims 12-14, and 31.

5. Claims 18 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata and Kasabach as applied to claim 1 and/or 23 above, and further in view of Dymetman et al (U.S. 6330976).

Regarding claims 18 and 35, the combinations of Tabata and Kasabach do not explicitly teach the method includes printing the coded data to be substantially invisible in the visible spectrum.

Dymetman, in the same field of endeavor for sensing device, teaches the method includes printing the coded data to be substantially invisible in the visible spectrum (col. 11, lines 45-67 to col. 12, lines 1-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata and Kasabach as per teachings of Dymetman because of a following reason: (1) to hide important coded data from being visible to an unauthorized users.

Therefore, it would have been obvious to combine Tabata and Kasabach with Dymetman to obtain the invention as specified in claims 18 and 35.

### ***Conclusion***


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER